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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,351	09/30/2003	William T. Ball	P06545US0-144	5782

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EXAMINER

NICHOLSON, ERIC K

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,351

Applicant(s)

BALL, WILLIAM T.

Examiner

Eric K Nicholson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 22, 2004 has been entered.

Claim Objections

The disclosure is objected to because of the following informalities: In claim 1, line 18; claim 4, line 17; claim 5, line 17, the term "wall" appears to be misspelled and should be changed to "well".

Appropriate correction is required.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 4,266,813 to Oliver. The Oliver device illustrates applicant's invention in fig. 6 with a pipe coupling for joining a first pipe to pipes of varying diameters including a first metal (as shown by the cross-hatchings) hollow fitting having opposite first and second ends (see fig. 6), with the first end being adapted for connection to a first pipe 22, a second and plastic hollow fitting 10 having first and second ends with the second end 18 being joined inside the second end of the first hollow fitting in sealed condition to define a fluid conduit extending through interiors of the first and second hollow fittings. As best shown in figure 3, the second fitting includes first 28 and second 26 adjacent wells in the second hollow fitting 10, with the first well being adjacent the second end of the

second fitting and having an upper end terminating in the first well at a shoulder portion. The first and second wells being cylindrical in shape with the second wall having a diameter greater than the diameter of the first well, whereupon inlet pipes 30,32 (figs 5 and 6) having outside diameters complimentary in size to the diameters of the wells can be selectively and alternately secured within the respective wells to fluidly connect such pipes to the fluid conduit and the first hollow fitting.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,612,584 to Taylor in view of U.S. patent 4,712,812 to Weir, III.

The Taylor device illustrates applicant's invention in fig. 2 with a metal to plastic transition coupling for joining a first pipe to together pipes including a first metal 20 hollow fitting having opposite first and second ends, with the first end being adapted for connection to a first pipe 12, a second and plastic hollow fitting 32 having first and second ends with the second end 30 being joined inside the second end 19 of the first hollow fitting in sealed condition to define a fluid conduit extending through interiors of the first and second hollow fittings. The second fitting includes well 36 at its first end for accepting pipe 14. However the Taylor coupling does not disclose multiple wells in the first end of the second fitting for accepting pipes of differing diameters. Weir, III discloses in figure 7 for example that it is known in the art to provide a similar type coupling 43 with one end 50 for insertion into a member and another end 44 having multiple wells 48,46 with walls 49,47 for accepting pipes of differing diameters such as is illustrated in figures 2 and 3 wherein pipes 118 and 121 of differing diameters are shown in the stepped wells. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the first end 34 of the second fitting 32 of Taylor with multiple wells for pipes of differing diameters as taught by Weir, III

(figs. 2,3,7) in place of the single well 36 in order for the coupling to be more versatile by accepting more than just one size pipe.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive. On page 5 of the remarks the applicant has recited various case law citations which discuss the proper usage of 35 U.S.C. section 102(b), the examiner agrees with the citations and believes to be in compliance with the law. Applicant argues that the claims *as amended* now define over the prior art used in the previous final rejection. As to claim 1, applicant specifically argues that the Oliver device does not include "a first hollow fitting....having a sleeve with a detent" nor "a second hollow fitting....with the second end having a groove for receiving the detent of the first hollow fitting". The examiner disagrees, as clearly shown in fig. 6 the thread 18 of the second hollow fitting 10 provides a helical groove at its second end. The helical groove of the male thread 18 receives the helical detent of the of the female thread of the first hollow fitting 20.

Applicant further argues that claim 5 as now amended defines over the Oliver device since the claim now recites that second end of the second fitting is slidably within the second end of the first hollow fitting. Again the examiner disagrees, as clearly shown in fig. 6 the second end of the second fitting 18 is threaded within

the second end of the first hollow fitting. It is the examiners position that threading an element into another element reads on the claim limitation of “sliding” since plainly the flanks of the male threads slide past the flanks of the threads of the female threads as the second member is slid in the axial direction to fit into the first member. Applicant further argues that the Oliver device does not teach a smooth continuous surface and instead teaches male threads 18 for the hose fitting 20. Here applicant’s arguments appear more limiting than the claims themselves since the claims do not recite “a smooth continuous surface” as argued.

As to the rejection of claim 1-6 under 35 U.S.C. section 103 applicant presents on pages 7-9 various case law citations which discuss the proper usage of 35 U.S.C. section 103 to which the examiner agrees with the citations and believes to be in compliance with the law. Applicant argues on page 9 that the examiner has used impermissible hindsight and lack of motivation to combine.

“Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts or findings that might serve to support a proper obviousness analysis.”

The examiner disagrees, as was pointed out in the rejection such motivation can be found in **“order for the coupling to be more versatile by accepting more than just one size pipe”**. While applicant argues that no information in Taylor suggests such a combination the examiner points out **first**, that if it did the

rejection would be made under *anticipation* and not *obviousness* and **second, as** applicant has already made clear in the remarks on page 8, lines 29-32

“Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references.

Suggestion need not come from the prior art references themselves but may come from the nature of the problem solved. It is the position of the examiner that where a person having an ordinary skill in the art is faced with the problem of not having a fitting of the proper size for various size pipe one would look to such a teaching as Weir, III wherein it is known to provide stepped internal diameters of increasing size in order to reduce the need for multiple conventional fittings. See column 1, lines 10-25. A person of ordinary skill in the art would readily recognize such a feature as an obvious expedient and therefor such a modification does not patentably define over the prior art. Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209

(CCPA 1971). Also the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant further argues that even if the prior art was combinable it would not read on the claims as now amended. As discussed above the examiner disagrees, as clearly shown in fig. 2 the thread 30 of the second hollow fitting 32 provides a helical groove at its second end. The helical groove of the male thread 30 receives the helical detent of the female thread of the first hollow fitting 20. Applicant further argues that claim 5 as now amended defines over the prior art combination since the claim now recites that second end of the second fitting is **slidably** within the second end of the first hollow fitting. Again the examiner disagrees, as clearly shown in fig. 2 the second end 30 of the second fitting 32 is threaded within the second end of the first hollow fitting 20. It is the examiners position that threading an element into another element reads on the claim limitation of “sliding” since plainly the flanks of the male threads **slide** past the flanks of the threads of the female threads as the second member is slid in the axial

direction to fit into the first member. As to the amendment to claim 4 see column 2, lines 45-50 which clearly discloses that a pipe 14 is secured via a suitable adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

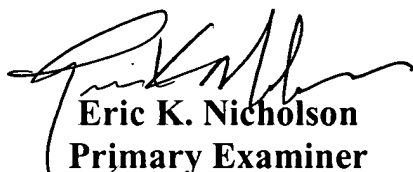
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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2/10/05


Eric K. Nicholson
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